

ADMINISTRATIVE PANEL DECISION

Tricots Saint-James v. 杨以亦 (Martin Parker)
Case No. D2024-2939

1. The Parties

The Complainant is Tricots Saint-James, France, represented by Fidal, France.

The Respondent is 杨以亦 (Martin Parker), China and United States of America (“U.S.”).

2. The Domain Name and Registrar

The disputed domain name <saintjamesonline.shop> is registered with West263 International Limited (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on July 19, 2024. On July 22, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 23, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (No information) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 29, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint in English on July 30, 2024.

On July 29, 2024, the Center informed the Parties in Chinese and English, that the language of the Registration Agreement for the disputed domain name is Chinese. On July 30, 2024, the Complainant requested English to be the language of the proceeding. The Respondent did not submit any comment on the Complainant’s submission.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent in Chinese and English of the Complaint, and the proceedings commenced on September 24, 2024. In accordance with

the Rules, paragraph 5, the due date for Response was October 14, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on October 15, 2024.

The Center appointed Rachel Tan as the sole panelist in this matter on October 18, 2024. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant is a company based in France. Since 1889, the Complainant has been manufacturing and selling clothing and fashion accessories for men, women and children under the SAINT JAMES trade mark. The Complainant has more than 173 points of sale in France and Europe.

The Complainant is the owner of the SAINT JAMES trade mark in different jurisdictions. For example, French Trade Mark Registration No. 4000393 for SAINT JAMES registered on October 4, 2013 in Classes 3, 14, 18, 24, and 25; European Union Trade Mark No. 6625339 for SAINT JAMES registered on December 12, 2008 in class 25; and International Trade Mark Registration No. 1178246 for SAINT JAMES registered on May 2, 2013 in classes 3, 14, 18, 24, and 25 designating, inter alia, China.

In addition, the Complainant is the registrant of numerous domain names incorporating the SAINT JAMES mark, for example <saint-james.com>, <saint-james.shop>, and <saintjames.shop>. The Complainant has used its SAINT JAMES mark on the websites and conducted sales and marketing thereon.

The disputed domain name was registered on June 5, 2024. Based on the undisputed evidence submitted by the Complainant, the disputed domain name previously resolved to a website in French which was allegedly a knock-off version of the Complainant's official website. In particular, it was alleged to offer the Complainant's products for sale by prominently displaying the Complainant's SAINT JAMES mark with the Complainant's original product images. At the time of this Decision, the disputed domain name does not resolve to an active website.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that the disputed domain name is identical or confusingly similar to the Complainant's SAINT JAMES mark. The Complainant's SAINT JAMES mark is incorporated in the disputed domain name in its entirety. The additional generic term "online" does not prevent a finding of confusing similarity.

The Complainant further alleges that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent has not received any licence or authorization of any kind to use the Complainant's trade mark in a domain name or otherwise. There is no evidence that the Respondent is known by the disputed domain name. Moreover, the Complainant has submitted evidence and alleges that the disputed domain name was previously operated as a website to impersonate the Complainant to sell counterfeit SAINT JAMES products. Accordingly, the Respondent is not using the disputed domain name with a bona fide offering of goods or services.

Finally, the Complainant argues that the disputed domain name was registered and is being used in bad faith. It is alleged that the disputed domain name previously resolved to a website that imitated the Complainant's official website with substantially similar layout and products photos. The Complainant

contends that the website noticeably displayed the Complainant's SAINT JAMES mark and likewise offered clothing products for sale. The registration and use of the disputed domain name is used for the sole aim of attracting for commercial gain, Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's SAINT JAMES mark as to the source, affiliation, and endorsement of the Respondent's website.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

6.1. Preliminary Issue: Language of the Proceeding

The language of the Registration Agreement for the disputed domain name is Chinese. Pursuant to the Rules, paragraph 11(a), in the absence of an agreement between the parties, or unless specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement.

The Complaint was filed in English. The Complainant requested that the language of the proceeding be English for several reasons, including the fact that (i) the registration data of the Respondent indicated that he is based in the U.S. which can presume the Respondent understands English; (ii) English is the common language used internationally; and (iii) the Complainant is based in France and conducting proceedings in Chinese would add unnecessary cost to the Complainant.

The Respondent did not make any specific submissions with respect to the language of the proceeding.

In exercising its discretion to use a language other than that of the registration agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both parties, taking into account all relevant circumstances of the case, including matters such as the parties' ability to understand and use the proposed language, time and costs (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.5.1).

Having considered all the matters above, the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English.

6.2. Substantive Issues

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. [WIPO Overview 3.0](#), section 1.7.

The Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms here, i.e. "online", may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Lastly, it is permissible for the Panel to disregard the applicable Top-Level Domain (“TLD”) in the disputed domain name, i.e. “.shop”. It is accepted by UDRP panels that the practice of disregarding the TLD in determining identity or confusing similarity is applied irrespective of the particular TLD (including with regard to “new generic TLDs”) and the ordinary meaning ascribed to a particular TLD would not necessarily impact assessment to the first element. [WIPO Overview 3.0](#), sections 1.11.1 and 1.11.2. See also *Wig Studio 1, LLC v. Jamar Harry*, WIPO Case No. [D2023-2550](#).

Based on the available record, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant’s prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

The Respondent has not provided evidence of a legitimate or noncommercial use of the disputed domain name or reasons to justify the choice of the disputed domain name that is confusingly similar to the Complainant’s SAINT JAMES mark. There is also no indication to show that the Respondent is commonly known by the disputed domain name or otherwise has rights or legitimate interests in it. Moreover, the Complainant has not granted the Respondent any license or authorization to use the Complainant’s SAINT JAMES mark or register the disputed domain name.

The Panel notes that the disputed domain name previously resolved to a website which allegedly imitated the Complainant’s official website with similar layout and products photos. The website noticeably displayed the Complainant’s SAINT JAMES mark and likewise offered clothing products for sale. The website did not accurately and prominently disclose the lack of a relationship between the Complainant and the Respondent. Therefore, the facts do not support a claim of bona fide use under the “Oki Data test”. See *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#), and [WIPO Overview 3.0](#), section 2.8.

Furthermore, the nature of the disputed domain name carries a risk of implied affiliation with the Complainant. [WIPO Overview 3.0](#), section 2.5.1.

None of the circumstances in paragraph 4(c) of the Policy are present in this case. For these reasons, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

Based on the available record, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel notes that the Complainant's SAINT JAMES mark was registered well before the registration of the dispute domain name. According to the Complainant, the first use of the mark was over 100 years ago. Through use and advertising, the Complainant's mark is known throughout the world. Search results using the key words "Saint James" on Internet search engines refers almost exclusively to the Complainant. The Panel notes that the disputed domain name previously resolved to a website allegedly displaying the Complainant's SAINT JAMES mark. As such, the Respondent clearly knew of the Complainant's mark when registering the disputed domain name. [WIPO Overview 3.0](#), section 3.2.2.

The Panel is of the view that by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the Respondent's website, by creating a likelihood of confusion with the Complainant's SAINT JAMES mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website. This demonstrates bad faith registration and use of the disputed domain name, as provided in paragraph 4(b)(iv) of the Policy.

The Panel notes that the disputed domain name currently resolves to an inactive website. The current inactive use of the disputed domain name in this case would not prevent a finding of bad faith under the doctrine of passive holding. In its determination, the Panel considers the degree of reputation of the Complainant's SAINT JAMES mark, the Respondent's failure to respond in the face of the Complainant's bad faith allegations, as well as the implausibility of any good faith use that the disputed domain name may be put especially considering the disputed domain name is inherently misleading. [WIPO Overview 3.0](#), section 3.3.

Given all the circumstances of the case, the Panel finds that the Respondent must have known of the Complainant before registering the disputed domain name, and considering the Respondent's lack of rights or legitimate interests, and by registering and using the disputed domain name as discussed above as well as continuing to hold the disputed domain name, the Panel is led to conclude that the disputed domain name was registered and is being used in bad faith.

Based on the available record, the Panel finds that the Complainant has established the third element of the Policy.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <saintjamesonline.shop> be transferred to the Complainant.

/Rachel Tan/

Rachel Tan

Sole Panelist

Date: October 31, 2024